

REMARKS

I. Status of Claims

Claims 1-78 were originally filed in the application. In a first office action, claims 1, 2, 8-12, 19-20, 21-23, 29-32, 38-39, 40-41, 47-51, 57-58, 70-71, 59-61, 67-68 and 77-78 stood rejected under 35 U.S.C. §102(e) as being anticipated by Anderson, Jr. et al (US Patent No. 6,578,203). Claims 3-7, 14-18, 24-28, 33-36, 42-45, 52-56, 62-66 and 72-75 stood rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson, Jr. et al. (US Patent No. 6,578,203) in view of Narayanaswami (US Patent No. 6,657,654). In response to the first office action, claims 6, 13, 15, 17/ 23, 25-27, 32-68, 71, and 73-78 were cancelled, and claims 1-5, 7, 9, 10-12, 14, 16, 18-19, 21-22, 24, 28-29, 31, 70 and 72 were amended to place them in better form for allowance. The prior art of record cited against the independent claims was distinguished.

After a second office action dated November 17, 2005, made final, claims 1-5, 7-12, 14, 16, 18-22, 24, 28-31, 70 and 72 were rejected, Applicants submitted an amendment and response, and requested reconsideration. Applicants amended claims 1-3, 5, 7 and 8, and cancelled claim 4. Claims 1-3, 5, 7-12, 14, 16, 18-22, 24, 28-31, 69-70, and 72 remained pending in the case.

On March 6, 2006, an advisory action was received from the office indicating that the amendment submitted by Applicant would not be entered because it raised new issues. Applicant filed an RCE on March 15, 2006 and included the un-entered amendment.

A first office action following the RCE filing was received from the office April 17, 2006 wherein claims 1-3, 5, 7-12, 14, 16, 18-22, 24, 28-31, 69, 70 and 72 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson et al (US Patent #6,578,203) in view of Duhault (US Patent #6,456,334). Applicants respectfully request reconsideration of the claims in light of the following remarks.

II. Rejection of claim 1-3, 5, 7-12, 14, 16, 18-22, 24, 28-31, 69, 70 and 72 under 35 U.S.C. §103(a) as being unpatentable over Anderson et al. in view of Duhault.

Requirements for Prima Facie Obviousness

The obligation of the Examiner to go forward and produce reasoning and evidence in support of obviousness under 35 U.S.C. §103 is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness necessary for establishing a rejection to a claim under 35 U.S.C. §103:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

A *prima facie* case of obviousness is further established when the Examiner provides:

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

See: *In re Lueders*, 111 F.3d 1569-71, 42 USPQ2d 1481-84 (Fed Cir. 1997), and *In re Berg*, 320 F.3d 1310, 65 USPA2d 2003, 2007 (Fed. Cir. 2003). It follows that in the absence of such a *prima facie* showing of obviousness under 35 U.S.C. §103 by the examiner (assuming there are no objections or other grounds for rejection), an Applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, in order to support an obviousness rejection under 35 U.S.C. §103, the Examiner is obliged to produce evidence compelling a conclusion that each of the aforementioned criteria has been met. If the Examiner fails to produce such a conclusion for each of the aforementioned criteria, the rejection must be withdrawn.

As admitted during the prosecution history by the examiner, “the Anderson device lacks the use of simultaneous displaying more than one in-play camera view.” The Examiner has acknowledged during prosecution that patent references Anderson, Jr. et al (US Patent No. 6,578,203) alone does not teach the display of more than one in-play camera view on a hand held device. Anderson et al likely did not teach simultaneous video display because it was not obvious during the time of the Anderson et al patent application filing, and also because Anderson was not anticipated to be operated as a “hand held device.” The Anderson et al device specifically refers to use of a “head mounted display” and is entitled “audio/video signal distribution system for Head Mounted displays.” A user of a head mounted display form factor, would not be interesting in the *simultaneous* viewing of video captured from more than one video source. Regardless of what form factor was used by Anderson et al, simultaneous display of more than one video and the ability to select a single for viewing on a display was not taught, hinted at or suggested by Anderson et al.

The Applicants’ invention is used in the field of “entertainment” and enables simultaneous, real-time viewing/display of video images on displays associated with hand held devices. The key feature of Appellants’ invention is simultaneous viewing of more than one video image captured by cameras at an entertainment venue on a single display associated with wireless, portable hand held devices. Another feature is in the ability for users to use a hand held

device to view in-play camera views received at an entertainment venue together with other simultaneously transmitted video signals.

The Examiner now cites to Duhault (US Patent #6,657,654), which was made public on September 24, 2002 for the teaching simultaneous display. Dehault fails as a reference under 35 U.S.C. §103 for two reasons. First, Dehault's effective publication date post dates the filing of Applicants' patent application. In order to establish a prima facie case, the examiner is required to cite references that are proper prior art. The CCPA has defined a reference under the patent laws as follows:

What is a "reference"? It is nothing more than a patent or publication cited to show that all or part of the invention for which a patent is sought was in the prior art, either more than a year before the filing date to which the applicant is entitled, in which case it is a "Statutory bar" and cannot be sworn back of, or before the applicant's date of invention.

In re Stempel, 241 F.2d 755, 113 USPQ 77, 81 (C.C.P.A. 1957).

Duhault was only first published as a patent on September 24, 2002. Applicants' filed their patent application in December 2001; Therefore, Dehault would not have been available as a reference to those skilled in the art to be combined with Anderson et al as suggested by the examiner.

Dehault is cited for its teaching simultaneous display of more than one video in a display of a data processing system. The Duhault reference does not discuss the use of portable, wireless devices. The Duhault reference teaches a system, as shown in Figure 11 (copied below), that would likely be used to work with the methodologies taught therein. One skilled in the art would not find a suggestion in Duhault, even if it were available before Applicants' filing date, that would motivate the combination with Anderson et al to provide simultaneous viewing of video on a portable, hand held device at a live entertainment venue.

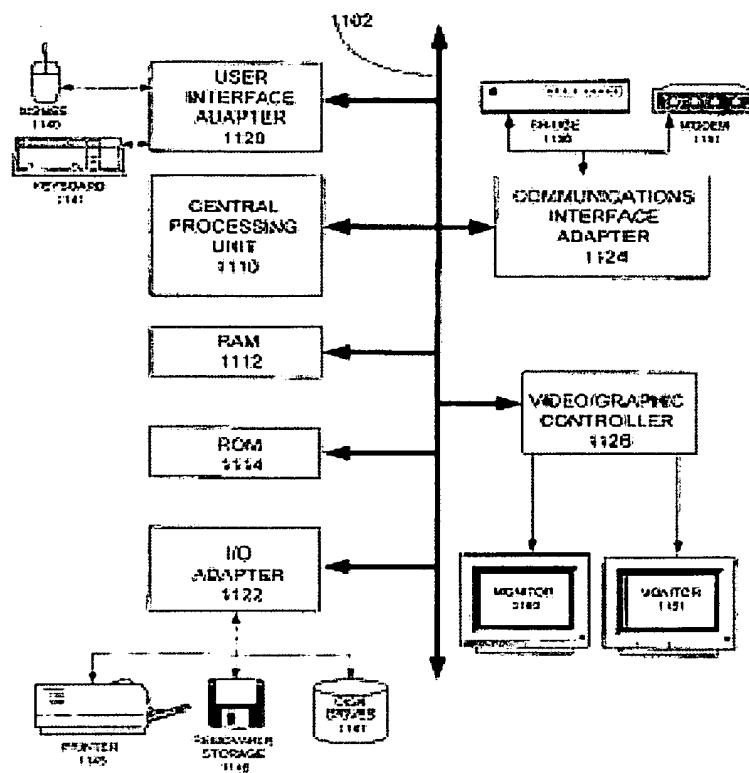


FIG. 11

Duhault's system.

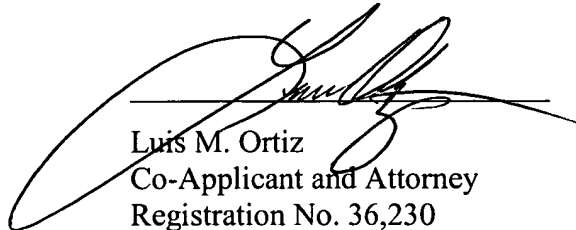
III. Conclusion

Applicants have responded to each and every rejection of the Official Action. Applicants submit that the above amendment and remarks place the pending claims in a condition for allowance. Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §103 based on the remarks. Reconsideration and early allowance of Applicants' application is also respectfully solicited.

The Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application should there be any outstanding matters that need to be resolved in the present application.

Respectfully submitted,

Dated: July 17, 2006

A handwritten signature in black ink, appearing to read 'Luis M. Ortiz', is written over a horizontal line.

Luis M. Ortiz
Co-Applicant and Attorney
Registration No. 36,230
ORTIZ & LOPEZ, PLLC
P.O. Box 4484
Albuquerque, NM 87196-4484

(505) 314-1311
lortiz@olpatentlaw.com